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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,750	08/26/2003	Richard De La Cruz		2289

7590 07/25/2005

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EXAMINER

WYSZOMIERSKI, GEORGE P

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/647,750

Applicant(s)

DE LA CRUZ, RICHARD

Examiner

George P. Wyszomierski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

1. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 contains an improper Markush group. In line 5 of this claim, the phrase "the list of" should be changed to read --the group consisting of--.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by any of Hardesty (U.S. patent 3,571,900), MacDonald (U.S. patent 4,326,326), Lin (U.S. patent 5,433,440), Rose et al. (U.S. patent 5,797,176), or Takeda (PG Publication 2002/0095762).

All of the above documents disclose methods of making golf clubs which include one of the steps as recited in line 6 of instant claim 1, together with a finishing step or steps of some sort, and an assembly step that utilizes some type of mechanical attachment to assemble parts of a golf club together. Thus, all aspects of the claimed invention are held to be fully disclosed by Hardesty, MacDonald, Lin, Rose et al., or Takeda.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hardesty, MacDonald, Lin, Rose et al., or Takeda, any of which in view of Yamashita et al. (U.S. patent 5,378,295).

The primary references, discussed supra, do not disclose a step of heat treating face plate and sole plate components separately from other components, as required by the instant claim. Yamashita indicates that it was well-known in the art, at the time of the invention, to heat treat face plate and sole plate components separately in a process of assembling golf clubs, i.e. in a process analogous to that of the primary references. Note particularly example 3 of Yamashita. Based on this disclosure of Yamashita et al., it would have been considered an obvious expedient by one of ordinary skill in the art to include the heat treating step as presently claimed when making golf clubs by any of the methods as disclosed by Hardesty, MacDonald, Lin, Rose et al., or Takeda.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hardesty, MacDonald, Lin, Rose et al., or Takeda, any of which in view of any of Shira (U.S. Patent 5,669,825), Minabe (U.S. Patent 5,961,394), Bristow et al. (U.S. patent 6,001,495), Chiu et al. (U.S. patent 6,617,537), Huang (U.S. patent 6,852,041), or JP 2003-52867.

The primary references do not disclose an electron beam welding step as required by the instant claim. Each of Shira, Minabe, Bristow, Chiu, Huang, and JP '867 indicate the conventionality in the art of using an electron beam welding step when assembling parts of golf clubs, i.e. when performing a process analogous to the processes as taught by Hardesty, MacDonald, Lin, Rose et al., or Takeda. The secondary references (Shira, Minabe, Bristow, Chiu, Huang, and JP '867) further disclose the relative advantages of electron beam welding in such processes. Consequently, the combined disclosures of any one of Hardesty, MacDonald, Lin, Rose et al., or Takeda, together with any one of Shira, Minabe, Bristow, Chiu, Huang, or JP '867, would have taught the claimed invention to a person of ordinary skill in the art.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hardesty, MacDonald, Lin, Rose et al., or Takeda, any one of which in view of Shira.

The primary references do not disclose the use of an adhesive as required by the instant claim. Shira column 4, lines 21-26 discloses the known equivalence in the golf club assembly art of employing techniques such as adhesive bonding, mechanical fastening, or electron beam welding. Based upon this disclosure of Shira, it would have been an obvious expedient to one of skill in the art to substitute adhesive bonding for any of the mechanical fastening steps of the primary references, based on the known equivalence of such steps in the golf club assembly art.

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8. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/647562.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant claim and the '562 claim are directed to methods of making golf clubs that include casting, finishing and assembling of golf club components. All of the steps appear to be performed in the same order and for the same purpose in the present claim and that as set forth in claim 1 of the '562 application. Thus, while the two claims are not verbatim identical, no patentable distinction is seen between the process as define din instant claim 1 and claim 1 of the '562 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (571) 272-1252. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (571) 272-1244. Effective July 15, 2005, all patent application related correspondence transmitted by facsimile must be directed to the new central facsimile number, (571)-273-8300. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



GEORGE WYSZOMIERSKI
PRIMARY EXAMINER
GROUP 1700

GPW
July 21, 2005